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(ew)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/548,409 04/13/00 STEWARD

L 17282CIP (AP)

HM12/0418

EXAMINER

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ART UNIT	PAPER NUMBER
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1644

DATE MAILED:

04/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/548,409	STEWARD ET AL
Examiner	Art Unit	
Karen Clemens	1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 13 April 2000.

2a) This action is FINAL.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) \_\_\_\_\_ is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claims 1-18 are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) <input type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s).(PTO-1449) Paper No(s) _____	20) <input type="checkbox"/> Other: _____

**DETAILED ACTION**  
**Election/Restriction**

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-4315. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Ph.D., Supervisory Patent Examiner at Paula.Hutzell@uspto.gov or 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

1. This Application, which contains nucleotide and amino acid sequences, is in compliance with the requirements of 37 C.F.R. 1.821-1.825.
2. The numbering of claims is not in accordance with 37 C.F.R. 1.126. The original numbering of the claims must be preserved throughout the prosecution. When claims are cancelled, the remaining claims must not be renumbered. When claims are added, except when presented in accordance with 37 C.F.R. 1.121(b), they must be renumbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not). Misnumbered claim 1 (second claim 1) to 18 have been renumbered 2 to 19. The claim dependency was not changed.
3. Restriction to one of the following inventions is required under 35 U.S.C. §121:
  - I. Claims 1-13, drawn to a composition comprising a binding element, a translocation element and a therapeutic element classified in Class 514, subclass 12 and Class 424, subclass 94.1.
  - II. Claims 14-19, drawn to a method of making a therapeutic polypeptide, classified in Class 435, subclass 68.1 and 69.1.
4. The inventions are distinct, each from the other because of the following reasons:

Groups I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other

and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case, the product can be made using *in vitro* peptide synthesis and protein modification methods.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.
6. Applicant is further required under 35 U.S.C. §121, if Group I is elected, to elect a composition comprising:

- A. a specific translocation element such as those disclosed in the specification on page 25, lines 7-17, for example:
  - a) N-terminal peptide half of the heavy chain of a *Clostridium tetanus* neurotoxin or
  - b) N-terminal peptide half of the heavy chain of a *Clostridium botulinum* neurotoxin.
- B. a specific therapeutic element cleaving the SNARE protein such as the ones disclosed in the specification, page 9, lines 12-25, for example:
  - a) BoNT/B, D, F, G or TeNT cleaving VAMP,
  - b) BoNT/C1 cleaving Syntaxin or
  - c) BoNT/A or E cleaving SNAP-25.

The translocation elements such as the one from the N-terminal peptide half of the heavy chain of *Clostridium tetanus* neurotoxin or from the N-terminal peptide half of the heavy chain of *Clostridium botulinum* neurotoxin have different amino acid sequences and are therefore patentably distinct.

The therapeutic elements have different amino acid sequences and target different SNARE proteins such as Syntaxin, SNAP-25 and VAMP and are therefore patentably distinct.

7. Applicant is required under 35 U.S.C. §121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1-13 are generic.

8. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

9. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP 809.02(a).

10. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(l).

12. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Clemens whose telephone number is (703) 308-8365. The examiner can normally be reached Monday through Friday from 8:00 AM to 6:00 PM. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-7401.

Karen Clemens, Ph.D.

Patent Examiner

Technology Center 1600

April 16, 2001

PHILLIP GAMBEL

PHILLIP GAMBEL, PH.D  
PRIMARY EXAMINER

TECH CENTER 1600

4/16/01